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S. Sand
PATENT APPLICATION
6/30/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masaru TAKEDA et al.

Group Art Unit: 2142

Application No.: 09/716,415

Examiner: H. Nguyen

Filed: November 21, 2000

Docket No.: 107904

For: INFORMATION OUTPUT SYSTEM UTILIZING ELECTRONIC MAIL

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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MAY 26 2004

Technology Center 2100

Sir:

In reply to the February 25, 2004 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-21 are pending herein.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Nguyen in the May 21, 2004 interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

I. Rejections Under 35 U.S.C. §103(a)

Claims 1-3 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,587,219 (hereinafter "Saito") in view of U.S. Patent No. 6,470,332 (hereinafter "Weschler").

Claims 4-11 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Saito in view of Weschler and further in view of U.S. Patent No. 6,223,226 (hereinafter "Miyahara").

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Saito in view of Weschler, further in view of Miyahara, and still further in view of an allegedly known feature of conversion of a PDL file.

Claims 14-16 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Saito in view of Weschler, in view of Miyahara, in view of an allegedly known feature of conversion of a PDL file, and further in view of the allegedly known feature of checking virus in electronic mail.

Claims 15-16 were rejected for the same rationale as claim 14. Claim 17 was rejected for the same rationale as claims 1 and 4. Claim 18 was rejected for the same rationale as claim 4. Claims 19-21 were rejected for the same rationale as claim 1.

These rejections are respectfully traversed.

Saito is directed towards an internet facsimile apparatus. As acknowledged by the Patent Office, Saito fails to teach or suggest searching a group for one candidate or a plurality of candidates in response to a search request, as recited in claims 1, 5, 17, 19, 20 and 21.

Specifically, the Patent Office states that Saito does not disclose searching an output apparatus group for one candidate output apparatus or a plurality of candidate output apparatuses in response to a search request from a terminal apparatus. However, the Patent Office alleges, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing searching an output apparatus group for one candidate output apparatus or a plurality of candidate output apparatuses in response

to a search request from a terminal apparatus. The Examiner then cites Weschler as allegedly curing the deficiency of Saito.

To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143. Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Here, even if the references could somehow have been combined, the Examiner has provided no motivation or suggestion as to why one would have combined the references. The Examiner merely states that Saito lacks a feature of the present invention and therefore one would be motivated to search related arts for this feature. However, such reasoning is solely improperly hindsight based.

As the Patent Office has clearly not met its initial burden of factually supporting any *prima facie* conclusion of obviousness, the Applicants are under no obligation to submit evidence of nonobviousness. See MPEP §2142.

Nonetheless, Applicants further submit that even if the references could have been combined, the presently claimed invention still would not have been achieved. The Patent Office cites Weschler as curing the deficiency of Saito. Specifically, the Patent Office cites the background of Weschler at col. 5, lines 7-64 when further alleging that it would have been obvious at the time the invention was made to have incorporated Weschler's teachings of searching resources by using directories with the teachings of Saito, for the purpose of allowing a user to initiate a search, for example, of an individual without knowing exactly

where he is located. However, Weschler, as noted by the Patent Office, merely discloses a problem with directories ("[these] directories do not interact with each other and so contain duplicative information and are difficult to consistently maintain"). See col. 4, lines 34-36 of Weschler.

The searching disclosed by Weschler includes "directory attributes" unrelated to output resources. Whereas, the present invention queries for an output resource and neither Saito, Weschler, nor Miyahara teach or suggest such searching. Further, nowhere does the features of conversion of a PDL file or checking virus in electronic mail cure this deficiency.

More specifically, neither Saito, Weschler, or Miyahara, alone or in combination, teach or suggest searching an output group/printer for one candidate or a plurality of candidates in response to a search request, as required by claims 1, 5, 17, 19, 20 and 21.

For the foregoing reasons, Applicants submit that Saito, Weschler, Miyahara, and the features of conversion of a PDL file and checking virus in electronic mail, alone or in combination, fail to teach or suggest the subject matter of independent claims 1, 5, 17, 19, 20 and 21 or dependent claims 2-4, 6-16 and 18.

Reconsideration and withdrawal of the rejections are thus respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: May 24, 2004

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